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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,182	08/02/2001	Gregory Maurice Plow	STL920000035US1	7553
7590	03/12/2004		EXAMINER	
John L. Rogitz Rogitz & Associates Suite 3120 750 B Street San Diego, CA 92101			MAMMEN, NATHAN SCOTT	
			ART UNIT	PAPER NUMBER
			3671	
DATE MAILED: 03/12/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

SK

Office Action Summary	Application No.	Applicant(s)	
	09/922,182	PLOW ET AL.	
	Examiner	Art Unit	
	Nathan S Mammen	3671	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 12 December 2003.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-22 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 20-22 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,317,761 to Landsman et al.

The Landsman '761 patent discloses a method and system for storing and viewing Internet advertisements. The method comprises receiving plural Internet advertisements (col. 9, lines 56-58), with at least one Internet advertisement including a tag (col. 9, line 64), and saving (col. 10, lines 12-24) the advertisements at the user computer at least partially based on the tag. The user accesses the advertisements in a browser window that, in the absence of any limitations to the contrary, is considered as an advertising history window. The Landsman '761 patent discloses that the advertisements are viewed using browser software such as INTERNET EXPLORER or NETSCAPE (col. 16, lines 34-39). The advertisements include a HTML tag (col. 17, lines 27-36). Thus, a user may select a saved advertisement and display the referring content page. The method of viewing inherently comprises functions of the browser software (7).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,336,099 to Barnett et al. in view of U.S. Patent 6,317,761 to Landsman et al.

The Barnett '099 patent discloses a method and system for storing and viewing internet advertisements. Col. 8, lines 15-22. (While Barnett discloses the coupon packages file as comprising coupons and "other types of advertising materials," coupons themselves are advertisements.) The method and system comprise receiving a plurality of advertisements and saving the advertisements at the user computer. Col. 8, lines 29-34. The user can access the saved advertisements in an advertisement history window and can filter previously displayed advertisements so that only advertisement corresponding to selected attributes will be displayed. Col. 9, lines 1-33; Fig. 2. The method and system further comprise displaying the advertisements in response to the user toggling a display button. Figs. 2 and 4B. The advertisements are available offline. Fig. 4B. What the Barnett '099 patent does not disclose is that the advertisements include HTML tags and that the advertisements are viewed in a browser window that can click on the tags to access a website. The Landsman '761 patent also discloses a method for storing and viewing Internet advertisements. The method comprises receiving plural Internet advertisements (col. 9, lines 56-58), with at least one Internet advertisement including a HTML tag (col. 9, line 64), and saving (col. 10, lines 12-24) the advertisements at the user computer at least partially based on the tag. The advertisements are viewed using browser

software such as INTERNET EXPLORER or NETSCAPE (col. 16, lines 34-39); thus, the method and system of Landsman inherently comprises logic means for displaying the ads in response to toggled buttons, allowing the user to scroll through the advertisements, and displaying a “previous” and “next” button and accessing the advertisements in response to the toggling of these buttons since these are notoriously inherent functions of the aforementioned browser software. The saved advertisement also has a link to a website, and the website is accessed when the link on the advertisement is toggled (col. 17, lines 27-36). It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the browser-based advertisement display system and method disclosed in Landsman into the downloadable advertisement method and system disclosed by Barnett, in order to provide the users of the Barnett advertisement system with a familiar interface and an ability to access further advertisement information through the hyperlinked tags.

Response to Arguments

5. Applicant's arguments filed 12/12/03 have been fully considered but they are not persuasive.

Applicant's arguments regarding claims 1-19 are moot in view of the new grounds of rejection stated above. Barnett clearly discloses downloading the advertisements onto the users computer and allowing the user to filter through the advertisements – including while offline.

Regarding Applicant's arguments with respect to claim 20: The examiner respectfully submits that he is not missing any points; instead, the claim is missing limitations – at least the

Art Unit: 3671

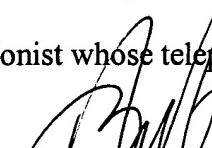
limitations that Applicant argues are present. Applicant states that “[claims 20-22] positively recite navigation through...an ad history window.” Remarks, page 9. They do not. Claim 20 recites the limitation of “viewing an advertisement history”. Claim 21 recites “toggling an advertisement history button...and viewing the advertisement history.” Nowhere do the claims mention an “ad history window.” Regardless, Applicant had not claimed anything that is not inherently provided for in the internet browser software used by Landsman. On its main toolbar, INTERNET EXPLORER has a button users can toggle to display browser history. NETSCAPE has similar tool. Thus, since advertisements are being displayed in these browsers, all a user would do is toggle the appropriate browser history button.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan Mammen whose telephone number is (703) 306-5959. The examiner can normally be reached Monday through Thursday from 6:30 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Thomas B. Will, can be reached at (703) 308-3870. The fax number for this Group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-1113.


Thomas B. Will
Supervisory Patent Examiner
Group 3600

NSM
3/6/04

Nathan S. Mammen